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Ross Koningstein

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EXAMINER

BRANDENBURG, WILLIAM A

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PAPER NUMBER

3622

NOTIFICATION DATE

DELIVERY MODE

09/03/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/748,681	Applicant(s) KONINGSTEIN, ROSS	
	Examiner WILLIAM A. BRANDENBURG	Art Unit 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 May 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-52 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>06/10/2009</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The following is a Final Office Action in response to communications received on 05/12/2009. No claims have been cancelled. Claims 1-2, 13-15, 18-19 and 35-36 have been amended. Claim 52 has been added. Therefore, claims 1-52 are pending and addressed below.

Information Disclosure Statement

2. The information disclosure statement (IDS) submitted on 06/10/2009 was filed after the mailing date of the Non-Final Office Action on 03/19/2009. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Rejections - 35 USC § 112

3. The amendment filed on 05/12/2009, has **NOT** corrected the 35 U.S.C. 112 deficiencies with respect to claims 18-34 identified in the Office Action dated 03/19/2009. Thus, the Examiner hereby maintains the 35 U.S.C. 112 second paragraph rejections of claims 18-34 that were raised in the Office Action dated 03/19/2009. See below for further detail.

4. The amendment filed on 05/12/2009, has corrected the 35 U.S.C. 112 deficiencies with respect to claims 35-51 identified in the Office Action dated 03/19/2009. Thus, the Examiner hereby withdraws the 35 U.S.C. 112 second paragraph rejections of claims 35-51 that were raised in the Office Action dated 03/19/2009.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Newly amended claims 1-2, 18-19 and 35-36 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 1 recites the amended limitation of "delivering, from a server at a first time, a first electronic document including a first and second instance of an electronic advertisement..." It

appears that based on the Applicant's arguments filed on 05/12/2009, the Applicant intends this current claim language to mean the first and second instance of the electronic advertisement is delivered at the same time. The Examiner does not see this intent required by the current claim language. However, even if this was required by the claim language, the Examiner can find no support in the Applicant's specification, even in paragraphs [0025-69] provided by the Applicant for support, in which the instant invention actually delivers both instances at the same time. The Examiner respectfully requests the Applicant specifically point out where support for these limitations can be found. Amended claims 18 and 35 are rejected for similar reasons.

Claim 2 recites "delivering the first electronic document including the electronic advertisement and enabling display to the user of the first electronic document in the expanded display format." (*emphasis added*) The Examiner notes the underlined portion above. The Examiner can find no support in the Applicant's specification for this particular amended limitation. In fact, the sections found by the Examiner that discloses the features of claim 2 actually teach away from this concept. Specifically, the Examiner notes paragraphs [0033] and [0067]. As per paragraph [0033], "the home icon may, upon selection, return the user to the original content/search page that included the

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expandable advertisement..." (*emphasis added*) The Examiner notes the underlined portion above. The recitation does not disclose that the document is displayed to the user with the advertisement in the second display format. Rather, the Examiner understands the "expandable" advertisement disclosed in paragraph [0033] to be the original compact form, which is what the Applicant has claimed prior to the amendments submitted on 05/12/2009. As such, it does not appear there is support in the Applicant's specification for this amended feature. The Examiner respectfully requests the Applicant specifically point out where support for these limitations can be found. Claims 19 and 36 are rejected for similar reasons.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 18-34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 18-34 recite the term "means for" and the Examiner is uncertain whether or not the Applicant is invoking 35 USC § 112,

sixth paragraph. The Examiner notes that although the Applicant states they intend to invoke 35 U.S.C. 112, 6th paragraph on page one of the Remarks, the Examiner is unable to find a specific definition in the Applicant's specification as to what is deemed a "means for". As such, the Examiner respectfully requests that if the Applicant is indeed invoking 35 USC § 112, sixth paragraph, that they provide the specific "means for" to the Examiner. If this information is not provided to the Examiner, then the next Action on the Merits will reflect that the Examiner is interpreting this to mean 35 USC § 112, sixth paragraph, is not being invoked. See MPEP § 2181 (II).

Claim Rejections - 35 USC § 101

7. The amendment filed on 05/12/2009, has corrected the 35 U.S.C. 101 deficiencies with respect to claims 35-51 identified in the Office Action dated 03/19/2009. Thus, the Examiner hereby withdraws the 35 U.S.C. 101 rejections of claims 35-51 that were raised in the Office Action dated 03/19/2009.
8. The amendment filed on 05/12/2009, has **NOT** corrected the 35 U.S.C. 101 deficiencies with respect to claims 1-17 identified in the Office Action dated 03/19/2009. Thus, the Examiner hereby maintains the 35 U.S.C. 101 rejections of claims 1-17 that were

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raised in the Office Action dated 03/19/2009. See below for further detail.

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. Claims 1-17 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Based on Supreme Court precedent, a method/process claim must (1) be tied to another statutory class of invention (such as a particular apparatus) (see at least *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (see at least *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972)). A method/process claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter.

Here claim 1 fails to meet the above requirements because the steps are neither tied to another statutory class of invention (such as a particular apparatus) nor physically transform underlying subject matter (such as an article or materials) to a

different state or thing. The Examiner notes that although claim 1 recites a "computer-implemented method", this preamble recitation in and of itself is not enough to overcome 35 U.S.C. 101.

Claim 1, for example, is drawn to method steps of delivering and receiving. Moreover, the Examiner notes that as per the amendment filed on 05/12/2009, the Applicant has amended these method steps to recite "delivering, from a server", "receiving, at the server" and "delivering, from the server a second later time". However, it is apparent that these amended method steps can still be considered extra-solution activity, none of which tie the method to a machine or apparatus. See In re Bilski, 99 USPQ2d 1385 (Fed. Cir. 2008) for further explanation or discussion related to extra-solution activity, especially footnote 14.

Generally, in order to tie the method to a machine or apparatus, there needs to be a positive recitation of a significant step (to illustrate the need, in converse to the term used in Bilski, this may be termed solution activity) being performed by the machine or apparatus.

No such recitation or indication is present in claim 1 of any physical transformation. Claim 1, then is not tied to another statutory class, nor is it physically transforming matter. Therefore claim 1 is directed to non-statutory subject matter.

Claims 2-17 depend from claim 1 and do not cure the deficiencies set forth above. As such, claims 2-17 are also rejected for being directed toward non-statutory subject matter.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. **Claims 1-12, 14-15, 18-29, 31-32, 35-46, 48-49 and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Petropoulos et al. (US 2003/0146939 A1) (hereinafter Petropoulos).**

11. As per claim 1, Petropoulos discloses a computer-implemented method for advertising comprising the steps of:

delivering, from a server at a first time, a first electronic document including a first and second instance of an electronic advertisement, the first instance being in a compact display format and including an associated expansion icon, the second

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instance being an expanded display format comprising one or more menu options and a reference, to a network location for retrieving specified content associated with each menu option, wherein the electronic advertisement is initially displayed to a user in the compact display format and is transitioned from the compact display format into the expanded display format upon a first user selection of the expansion icon associated with the first instance of the electronic advertisement ([0020-26], web page 59 delivered, search result 53, preview icon 63 associated with search result 53, upon action of pointer (i.e. mouse-over) embedded preview window opened and relevant contextual information inline with user's results rendered, actual content or web page referred by or associated with first result 53 as preview information, see also [0042], preview information displayed in preview window 55, functional attributes of preview window include enabling hyperlinks so that a mouse-over or click on a link within previewed page is active and result in a call to the referenced page, see also Fig. 1, "53", "63/64", "55", "57", "59");

receiving, at the server, a second user selection of one of the one or more menu options after the electronic advertisement has been transitioned from the compact display format into the expanded display format in the first electronic document ([0042], preview information displayed in preview window 55, functional

attributes of preview window include enabling hyperlinks so that a mouse-over or click on a link within previewed page is active and result in a call to the referenced page).

Petropoulos does not explicitly disclose

delivering, from the server at a second later time, a second electronic document including content from the referenced network location associated with the menu option selected and including the electronic advertisement, wherein the electronic advertisement displayed with the second electronic document to the user is initially displayed in the expanded display format.

However, Petropoulos does teach that actual content or the web page referred by or associated with first result 53 is displayed as preview information ([0020-24]). This preview information is displayed in preview window 55. The user may control functional attributes of the preview window including hyperlinks in which a mouse-over or click on a link within the previewed page results in a call to the referenced page ([0042], see also Fig. 1, "53", "63/64", "55", "57", "59").

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Petropoulos to include delivering a second document including the referenced content and

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the electronic advertisement initially displayed in the expanded format. The rationale for this inclusion is that this would enable Petropoulos to deliver the content while maintaining the advertising content in direct view of the user. Common sense dictates that the longer a user is subjected to particular content, the more impact and effect the content will have on the user. The Examiner notes that although the particular language of the instant invention is not explicitly disclosed in Petropoulos, based on the broadest reasonable interpretation, the Examiner understands the actual content or web page that is displayed as preview information to be the second instance, or expanded display format of the instant invention. Furthermore, the Examiner understands if this is indeed the preview information, by this preview information containing hyperlinks (i.e. menu options) which in turn calls upon activation to its respective referenced page, the returned content referenced by the hyperlinks would be the actual content or web page delivered as a web page (i.e. second electronic document). Based on the provided disclosures, this returned content would include both the referenced content and the expanded display format content, as the actual content or web page disclosed represents both of these elements. As such, the Examiner contends the limitations as currently written have been satisfied by the provided recitations.

12. As per claim 2, Petropoulos discloses the computer-implemented method of claim 1 (as rejected above).

Petropoulos does not explicitly disclose wherein one of the menu options includes a home menu option and further comprising:

receiving a selection of the home menu option; and

delivering the first electronic document including the electronic advertisement and enabling display to the user of the first electronic document in the expanded display format.

However, Petropoulos does teach preview information is displayed in preview window 55. The user may control functional attributes of the preview window including hyperlinks in which a mouse-over or click on a link within the previewed page results in a call to the referenced page ([0042], see also Fig. 1, "53", "63/64", "55", "57", "59"). In addition, Petropoulos teaches advanced preview icon implementation including separating regions in the preview icon which allows the user to dynamically and automatically determine what to preview via a variety of menu buttons ([0060-61], see also Fig. 5, "552", "Home Page").

Furthermore, Petropoulos teaches a mouse-over technology in which the user may simply move the pointer away from the preview and

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the window will close and return to the original display ([0054]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Petropoulos to include a home menu option to return to the original display. The rationale for this inclusion is a home option allows a user to easily return to the original content display to avoid the hassle of the typical backward-forward movement in a browser setting. The Examiner notes that although Petropoulos teaches various menu options, but does not explicitly teach a home option specifically in the preview window (i.e. expanded display), the taught menu options (i.e. functional attribute hyperlinks [0042]) could easily include a home menu option. Furthermore, there are a limited number of predictable ways to transition back to the original format. For example, one could either close the preview window (i.e. expanded display) by clicking a typical close "x" button, select a coded "home" button as disclosed in the instant application, or "deselect" (i.e. move away the cursor) the window as is taught by Petropoulos. As such, it would be obvious for Petropoulos to include a home menu option as opposed to its current teachings because the mouse-over technology yields the same functionality of returning to the original display format that the home menu option provides. The Examiner notes this

rationale has been based on the interpretation resulting from the 112 2nd paragraph rejection detailed above.

13. As per claim 3, Petropoulos discloses the computer-implemented method of claim 1 (as rejected above). Petropoulos further discloses wherein

the electronic advertisement comprises a morphing electronic advertisement that includes instructions for interpreting user actions to enable an end user system to display the compact display format and the expanded display format ([0020-26], web page 59 delivered, search result 53, preview icon 63 associated with search result 53, upon action of pointer (i.e. mouse-over) instructions are sent and embedded preview window opened and relevant contextual information inline with user's results rendered, actual content or web page referred by or associated with first result 53 as preview information, see also [0042], preview information displayed in preview window 55, functional attributes of preview window include enabling hyperlinks so that a mouse-over or click on a link within previewed page is active and result in a call to the referenced page, see also Fig. 1, "53", "63/64", "55", "57", "59").

14. As per claim 4, Petropoulos discloses the computer-implemented method of claim 1 (as rejected above). Petropoulos further discloses wherein

the first and second electronic document comprise web pages ([0010], preview information is a "preview window" containing relevant preview information of actual page or document associated with item in results list, see also [0020-25], search results web page 59, preview information displays actual content or the web page referred by or associated with the first result, see also Fig. 1, "59").

15. As per claim 5, Petropoulos discloses the computer-implemented method of claim 4 (as rejected above). Petropoulos further discloses wherein

the network locations specified in reference to the one or more menu options comprise network locations provided by or affiliated with a host entity that delivered the first electronic document and the electronic advertisement ([0025-26], preview information displays actual content or the web page referred by or associated with the first result, see also [0029], contextual information regards URL pertaining to web page, see also [0042], enabling active hyperlinks in preview windows so that a mouse-over or click result in a call to the referenced page as well as

enabling further mouse-over, which allows the user to use mouse-over in the preview pane).

16. As per claim 6, Petropoulos discloses the computer-implemented method of claim 1 (as rejected above). Petropoulos further discloses further comprising:

wherein the electronic advertisement comprises a target reference to an advertiser network location ([0025], preview information displays actual content or the web page referred by or associated with the first result, see also [0042], enabling active hyperlinks in preview windows so that a mouse-over or click result in a call to the referenced page).

Petropoulos does not explicitly disclose

storing a price parameter value in association with the electronic advertisement.

However, Petropoulos does teach various constraints are used to sort the pages returned as preview information ([0027-28]). In addition, Petropoulos teaches a user's use of preview information is monitored while the user reviews the results page. More specifically, it monitors which result is being previewed by order or rank, the length of each preview, whether there is a click-through, etc. The attributes of user behavior are forwarded

across the network and later used to improve relevancy ([0072-79]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Petropoulos to include storing a price parameter associated with the electronic advertisement. The Examiner notes that in an electronic advertising environment, it is common for there to be a direct correlation between price and performance parameters. As such, the act of monitoring performance (i.e. user interaction) in an online environment provides a way to measure the effectiveness of the content issued to the user, whether it be search results, banner advertisements, etc. Therefore, although Petropoulos does not explicitly teach storing a price value, it would be obvious for a price value to be present as a result of the monitoring and tracking of user performance recited in the teachings of Petropoulos.

17. As per claim 7, Petropoulos discloses the computer-implemented method of claim 6 (as rejected above). Petropoulos further discloses further comprising:

receiving a third user selection of the target reference, wherein performance is determined to have occurred upon receipt of the selection of the target reference ([0042], functional

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attributes of preview window include hyperlinks that a user can mouse over or click on which would result in a call to the referenced page, see also [0073-75], a user's use of preview information is monitored while the user reviews the results page, it monitors which result is being previewed by order or rank, the length of each preview, whether there is a click-through, etc., attributes of user behavior are forwarded across the network and later used to improve relevancy).

18. As per claim 8, Petropoulos discloses the computer-implemented method of claim 6 (as rejected above). Petropoulos further discloses further comprising:

receiving an indication of user activity associated with the expanded display format, wherein performance is determined to have occurred upon receipt of the indication of the user activity ([0042], functional attributes of preview window include the use of a scroll bar, hyperlinks that a user can mouse over or click on which would result in a call to the referenced page, etc., see also [0073], attributes of user behavior tracked and monitored).

19. As per claim 9, Petropoulos discloses the computer-implemented method of claim 8 (as rejected above). Petropoulos further discloses wherein

the user activity comprises a predetermined period of time viewing the expanded display format ([0042], user can dynamically control the duration of the preview window visibility, see also [0073-75], user's use of preview information monitored including the length of each preview, a long duration indicates high relevancy to a particular result).

20. As per claim 10, Petropoulos discloses the computer-implemented method of claim 8 (as rejected above). Petropoulos further discloses wherein

the user activity comprises the user request to view the expanded display format ([0010], displaying preview information associated with each result item, see also [0025], preview information shown when there is a mouse-over a defined area, see also [0073], user's use of preview information monitored including which result is being previewed).

21. As per claim 11, Petropoulos discloses the computer-implemented method of claim 8 (as rejected above). Petropoulos further discloses wherein

the user activity comprises a predetermined number of user selections of the one or more menu options available in the expanded display format ([0026], preview information include URLs, with respect to URLs used as preview information these URLs

will function as links, see also [0042], enabling active hyperlinks in preview windows so that a mouse-over or click result in a call to the referenced page as well as enabling further mouse-over, which allows the user to use mouse-over in the preview pane, see also [0073-75], a user's use of preview information is monitored while the user reviews the results page, it monitors which result is being previewed by order or rank, the length of each preview, whether there is a click-through, etc., attributes of user behavior are forwarded across the network and later used to improve relevancy).

22. As per claim 12, Petropoulos discloses the computer-implemented method of claim 1 (as rejected above). Petropoulos further discloses further comprising:

associating a reference to the electronic advertisement for use by the user in retrieving the electronic advertisement ([0025], preview information displays actual content or the web page referred by or associated with the first result, see also [0029], contextual information regards URL pertaining to web page, see also [0032], preview information includes tags defining the information to be previewed).

23. As per claim 14, Petropoulos discloses the computer-implemented method of claim 1 (as rejected above). Petropoulos further discloses wherein,

the second electronic document comprises a document provided by the advertiser ([0025], preview information displays actual content or the web page referred by or associated with the first result, see also [0042], enabling active hyperlinks in preview windows so that a mouse-over or click result in a call to the referenced page) (The Examiner understands the actual content or web page that is displayed as preview information to be the second instance, or expanded display format of the instant invention. Furthermore, the Examiner understands if this is indeed the preview information, by this preview information containing hyperlinks (i.e. menu options) which in turn calls upon activation to its respective referenced page, the returned content referenced by the hyperlinks would be the actual content or web page delivered as a web page (i.e. second electronic document). Based on the provided disclosures, this returned content would include both the referenced content and the expanded display format content, as the actual content or web page disclosed represents both of these elements.).

24. As per claim 15, Petropoulos discloses the computer-implemented method of claim 14 (as rejected above). Petropoulos further discloses wherein,

the document provided by the advertiser comprises a web page from the advertiser's web site ([0025], preview information displays actual content or the web page referred by or associated with the first result, see also [0042], enabling active hyperlinks in preview windows so that a mouse-over or click result in a call to the referenced page) (The Examiner understands the actual content or web page that is displayed as preview information to be the second instance, or expanded display format of the instant invention. Furthermore, the Examiner understands if this is indeed the preview information, by this preview information containing hyperlinks (i.e. menu options) which in turn calls upon activation to its respective referenced page, the returned content referenced by the hyperlinks would be the actual content or web page delivered as a web page (i.e. second electronic document). Based on the provided disclosures, this returned content would include both the referenced content and the expanded display format content, as the actual content or web page disclosed represents both of these elements.).

25. As per claim 18, Petropoulos discloses an apparatus for delivering advertising comprising:

an electronic advertisement output means for delivering at a first time a first electronic document including a first and second instance of an electronic advertisement, the first instance being in a compact display format and including an associated expansion icon, the second instance being an expanded display format comprising one or more menu options and a reference to a network location for retrieving specified content associated with each menu option, wherein the electronic advertisement is initially displayed to the user in the compact display format and is transitioned from the compact display format into the expanded display format upon a first user selection of the expansion icon associated with the first instance of the electronic advertisement ([0020-26], web page 59 delivered, search result 53, preview icon 63 associated with search result 53, upon action of pointer (i.e. mouse-over) embedded preview window opened and relevant contextual information inline with user's results rendered, actual content or web page referred by or associated with first result 53 as preview information, see also [0042], preview information displayed in preview window 55, functional attributes of preview window include enabling hyperlinks so that a mouse-over or click

on a link within previewed page is active and result in a call to the referenced page, see also Fig. 1, "53", "63/64", "55", "57", "59");

selection receiving means for receiving a second user selection of one of the one or more menu options after the electronic advertisement has been transitioned from the compact display format into the expanded display format ([0042], preview information displayed in preview window 55, functional attributes of preview window include enabling hyperlinks so that a mouse-over or click on a link within previewed page is active and result in a call to the referenced page).

Petropoulos does not explicitly disclose

delivery means for delivering at a second later time a second electronic document including content from the referenced network location associated with the menu option selected and including the electronic advertisement, wherein the electronic advertisement displayed with the second electronic document to the user is initially displayed in the expanded display format.

However, Petropoulos does teach that actual content or the web page referred by or associated with first result 53 is displayed as preview information ([0020-24]). This preview information is displayed in preview window 55. The user may control functional

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attributes of the preview window including hyperlinks in which a mouse-over or click on a link within the previewed page results in a call to the referenced page ([0042], see also Fig. 1, "53", "63/64", "55", "57", "59").

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Petropoulos to include delivering a second document including the referenced content and the electronic advertisement initially displayed in the expanded format. The rationale for this inclusion is that this would enable Petropoulos to deliver the content while maintaining the advertising content in direct view of the user. Common sense dictates that the longer a user is subjected to particular content, the more impact and effect the content will have on the user. The Examiner notes that although the particular language of the instant invention is not explicitly disclosed in Petropoulos, based on the broadest reasonable interpretation, the Examiner understands the actual content or web page that is displayed as preview information to be the second instance, or expanded display format of the instant invention. Furthermore, the Examiner understands if this is indeed the preview information, by this preview information containing hyperlinks (i.e. menu options) which in turn calls upon activation to its respective referenced page, the returned content referenced by the

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hyperlinks would be the actual content or web page delivered as a web page (i.e. second electronic document). Based on the provided disclosures, this returned content would include both the referenced content and the expanded display format content, as the actual content or web page disclosed represents both of these elements. As such, the Examiner contends the limitations as currently written have been satisfied by the provided recitations.

26. As per claim 19, Petropoulos discloses the apparatus of claim 18 (as rejected above).

Petropoulos does not explicitly disclose wherein

one of the menu options includes a home menu option and wherein

the selection receiving means receives a selection of the home menu option; and wherein

the delivery means delivers the first electronic document including the electronic advertisement and enabling display to the user of the first electronic document in the compact expanded display format.

However, Petropoulos does teach preview information is displayed in preview window 55. The user may control functional attributes

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of the preview window including hyperlinks in which a mouse-over or click on a link within the previewed page results in a call to the referenced page ([0042], see also Fig. 1, "53", "63/64", "55", "57", "59"). In addition, Petropoulos teaches advanced preview icon implementation including separating regions in the preview icon which allows the user to dynamically and automatically determine what to preview via a variety of menu buttons ([0060-61], see also Fig. 5, "552", "Home Page"). Furthermore, Petropoulos teaches a mouse-over technology in which the user may simply move the pointer away from the preview and the window will close and return to the original display ([0054]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Petropoulos to include a home menu option to return to the original display. The rationale for this inclusion is a home option allows a user to easily return to the original content display to avoid the hassle of the typical backward-forward movement in a browser setting. The Examiner notes that although Petropoulos teaches various menu options, but does not explicitly teach a home option specifically in the preview window (i.e. expanded display), the taught menu options (i.e. functional attribute hyperlinks [0042]) could easily include a home menu option. Furthermore, there are a limited

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number of predictable ways to transition back to the original format. For example, one could either close the preview window (i.e. expanded display) by clicking a typical close "x" button, select a coded "home" button as disclosed in the instant application, or "deselect" (i.e. move away the cursor) the window as is taught by Petropoulos. As such, it would be obvious for Petropoulos to include a home menu option as opposed to its current teachings because the mouse-over technology yields the same functionality of returning to the original display format that the home menu option provides. The Examiner notes this rationale has been based on the interpretation resulting from the 112 2nd paragraph rejection detailed above.

27. As per claim 20, Petropoulos discloses the apparatus of claim 18 (as rejected above). Petropoulos further discloses wherein the electronic advertisement comprises a morphing electronic advertisement that includes instructions for interpreting user actions to enable an end user system to display the compact display format and the expanded display format ([0020-26], web page 59 delivered, search result 53, preview icon 63 associated with search result 53, upon action of pointer (i.e. mouse-over) instructions are sent and embedded preview window opened and relevant contextual information inline with user's results rendered, actual content or web page referred by or associated

with first result 53 as preview information, see also [0042], preview information displayed in preview window 55, functional attributes of preview window include enabling hyperlinks so that a mouse-over or click on a link within previewed page is active and result in a call to the referenced page, see also Fig. 1, "53", "63/64", "55", "57", "59").

28. As per claim 21, Petropoulos discloses the apparatus of claim 18 (as rejected above). Petropoulos further discloses

wherein the first and second electronic document comprise web pages ([0010], preview information is a "preview window" containing relevant preview information of actual page or document associated with item in results list, see also [0020-25], search results web page 59, preview information displays actual content or the web page referred by or associated with the first result, see also Fig. 1, "59").

29. As per claim 22, Petropoulos discloses the apparatus of claim 18 (as rejected above). Petropoulos further discloses wherein

the network locations specified in reference to the one or more menu options comprise network locations provided by or affiliated with a host entity that delivered the first electronic document and the electronic advertisement ([0025-26], preview information displays actual content or the web page referred by

or associated with the first result, see also [0029], contextual information regards URL pertaining to web page, see also [0042], enabling active hyperlinks in preview windows so that a mouse-over or click result in a call to the referenced page as well as enabling further mouse-over, which allows the user to use mouse-over in the preview pane).

30. As per claim 23, Petropoulos discloses the apparatus of claim 18 (as rejected above). Petropoulos further discloses further comprising:

wherein the electronic advertisement comprises a target reference to an advertiser network location ([0025], preview information displays actual content or the web page referred by or associated with the first result, see also [0042], enabling active hyperlinks in preview windows so that a mouse-over or click result in a call to the referenced page).

Petropoulos does not explicitly disclose

storage means for storing a price parameter value in association with the electronic advertisement.

However, Petropoulos does teach various constraints are used to sort the pages returned as preview information ([0027-28]). In addition, Petropoulos teaches a user's use of preview information

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is monitored while the user reviews the results page. More specifically, it monitors which result is being previewed by order or rank, the length of each preview, whether there is a click-through, etc. The attributes of user behavior are forwarded across the network and later used to improve relevancy ([0072-79]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Petropoulos to include storing a price parameter associated with the electronic advertisement. The Examiner notes that in an electronic advertising environment, it is common for there to be a direct correlation between price and performance parameters. As such, the act of monitoring performance (i.e. user interaction) in an online environment provides a way to measure the effectiveness of the content issued to the user, whether it be search results, banner advertisements, etc. Therefore, although Petropoulos does not explicitly teach storing a price value, it would be obvious for a price value to be present as a result of the monitoring and tracking of user performance recited in the teachings of Petropoulos.

31. As per claim 24, Petropoulos discloses the apparatus of claim 23 (as rejected above). Petropoulos further discloses wherein

the selection receiving means receives a third user selection of the target reference, wherein performance is determined to have occurred upon receipt of the selection of the target reference ([0042], functional attributes of preview window include hyperlinks that a user can mouse over or click on which would result in a call to the referenced page, see also [0073-75], a user's use of preview information is monitored while the user reviews the results page, it monitors which result is being previewed by order or rank, the length of each preview, whether there is a click-through, etc., attributes of user behavior are forwarded across the network and later used to improve relevancy).

32. As per claim 25, Petropoulos discloses the apparatus of claim 23 (as rejected above). Petropoulos further discloses wherein

the selection receiving means receives an indication of user activity associated with the expanded display format, wherein performance is determined to have occurred upon receipt of the indication of the user activity ([0042], functional attributes of preview window include the use of a scroll bar, hyperlinks that a user can mouse over or click on which would result in a call to the referenced page, etc., see also [0073], attributes of user behavior tracked and monitored).

33. As per claim 26, Petropoulos discloses the apparatus of claim 25 (as rejected above). Petropoulos further discloses wherein the user activity comprises a predetermined period of time viewing the expanded display format ([0042], user can dynamically control the duration of the preview window visibility, see also [0073-75], user's use of preview information monitored including the length of each preview, a long duration indicates high relevancy to a particular result).
34. As per claim 27, Petropoulos discloses the apparatus of claim 25 (as rejected above). Petropoulos further discloses wherein the user activity comprises the user request to view the expanded display format ([0010], displaying preview information associated with each result item, see also [0025], preview information shown when there is a mouse-over a defined area, see also [0073], user's use of preview information monitored including which result is being previewed).
35. As per claim 28, Petropoulos discloses the apparatus of claim 25 (as rejected above). Petropoulos further discloses wherein the user activity comprises a predetermined number of user selections of the one or more menu options available in the expanded display format ([0026], preview information include URLs, with respect to URLs used as preview information these URLs

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will function as links, see also [0042], enabling active hyperlinks in preview windows so that a mouse-over or click result in a call to the referenced page as well as enabling further mouse-over, which allows the user to use mouse-over in the preview pane, see also [0073-75], a user's use of preview information is monitored while the user reviews the results page, it monitors which result is being previewed by order or rank, the length of each preview, whether there is a click-through, etc., attributes of user behavior are forwarded across the network and later used to improve relevancy).

36. As per claim 29, Petropoulos discloses the apparatus of claim 18 (as rejected above). Petropoulos further discloses further comprising

storage means that stores a reference to the electronic advertisement for use by the user in retrieving the electronic advertisement ([0025], preview information displays actual content or the web page referred by or associated with the first result, see also [0029], contextual information regards URL pertaining to web page, see also [0032], preview information includes tags defining the information to be previewed).

37. As per claim 31, Petropoulos discloses the apparatus of claim 18 (as rejected above). Petropoulos further discloses wherein

the second electronic document comprises a document provided by the advertiser ([0025], preview information displays actual content or the web page referred by or associated with the first result, see also [0042], enabling active hyperlinks in preview windows so that a mouse-over or click result in a call to the referenced page) (The Examiner understands the actual content or web page that is displayed as preview information to be the second instance, or expanded display format of the instant invention. Furthermore, the Examiner understands if this is indeed the preview information, by this preview information containing hyperlinks (i.e. menu options) which in turn calls upon activation to its respective referenced page, the returned content referenced by the hyperlinks would be the actual content or web page delivered as a web page (i.e. second electronic document). Based on the provided disclosures, this returned content would include both the referenced content and the expanded display format content, as the actual content or web page disclosed represents both of these elements.).

38. As per claim 32, Petropoulos discloses the apparatus of claim 31 (as rejected above). Petropoulos further discloses wherein

the document provided by the advertiser comprises a web page from the advertiser's web site ([0025], preview information displays actual content or the web page referred by or associated

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with the first result, see also [0042], enabling active hyperlinks in preview windows so that a mouse-over or click result in a call to the referenced page) (The Examiner understands the actual content or web page that is displayed as preview information to be the second instance, or expanded display format of the instant invention. Furthermore, the Examiner understands if this is indeed the preview information, by this preview information containing hyperlinks (i.e. menu options) which in turn calls upon activation to its respective referenced page, the returned content referenced by the hyperlinks would be the actual content or web page delivered as a web page (i.e. second electronic document). Based on the provided disclosures, this returned content would include both the referenced content and the expanded display format content, as the actual content or web page disclosed represents both of these elements.).

39. As per claim 35, Petropoulos discloses an apparatus for delivering advertising comprising:

a server ([0065], server 653) performing operations comprising delivering at a first time a first electronic document including, a first and second instance of an electronic advertisement, the first instance being in a compact display format and including an associated expansion icon, the second

instance being an expanded display format comprising one or more menu options and a reference to a network location for retrieving specified content associated with each menu option, wherein the electronic advertisement is initially displayed to a user in the compact display format and is transitioned from the compact display format into the expanded display format upon a first user selection the expansion icon associated with the first instance of the electronic advertisement ([0020-26], web page 59 delivered, search result 53, preview icon 63 associated with search result 53, upon action of pointer (i.e. mouse-over) embedded preview window opened and relevant contextual information inline with user's results rendered, actual content or web page referred by or associated with first result 53 as preview information, see also [0042], preview information displayed in preview window 55, functional attributes of preview window include enabling hyperlinks so that a mouse-over or click on a link within previewed page is active and result in a call to the referenced page, see also Fig. 1, "53", "63/64", "55", "57", "59");

receiving a second user selection of one of the one or more menu options after the electronic advertisement has been transitioned from the compact display format into the expanded display format ([0042], preview information displayed in preview window 55, functional attributes of preview window include

enabling hyperlinks so that a mouse-over or click on a link within previewed page is active and result in a call to the referenced page).

Petropoulos does not explicitly disclose

delivering at a second later time a second electronic document including content from the referenced network location associated with the menu option selected and including the electronic advertisement, wherein the electronic advertisement displayed with the second electronic document to the user is initially displayed in the expanded display format.

However, Petropoulos does teach that actual content or the web page referred by or associated with first result 53 is displayed as preview information ([0020-24]). This preview information is displayed in preview window 55. The user may control functional attributes of the preview window including hyperlinks in which a mouse-over or click on a link within the previewed page results in a call to the referenced page ([0042], see also Fig. 1, "53", "63/64", "55", "57", "59").

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Petropoulos to include delivering a second document including the referenced content and

the electronic advertisement initially displayed in the expanded format. The rationale for this inclusion is that this would enable Petropoulos to deliver the content while maintaining the advertising content in direct view of the user. Common sense dictates that the longer a user is subjected to particular content, the more impact and effect the content will have on the user. The Examiner notes that although the particular language of the instant invention is not explicitly disclosed in Petropoulos, based on the broadest reasonable interpretation, the Examiner understands the actual content or web page that is displayed as preview information to be the second instance, or expanded display format of the instant invention. Furthermore, the Examiner understands if this is indeed the preview information, by this preview information containing hyperlinks (i.e. menu options) which in turn calls upon activation to its respective referenced page, the returned content referenced by the hyperlinks would be the actual content or web page delivered as a web page (i.e. second electronic document). Based on the provided disclosures, this returned content would include both the referenced content and the expanded display format content, as the actual content or web page disclosed represents both of these elements. As such, the Examiner contends the limitations as currently written have been satisfied by the provided recitations.

40. As per claim 36, Petropoulos discloses the apparatus of claim 35 (as rejected above).

Petropoulos does not explicitly disclose wherein one of the menu options includes a home menu option and further comprising:

the server performing operations comprising receiving a selection of the home menu option; and

delivering the first electronic document including the electronic advertisement and enabling display to the user of the first electronic document in the expanded display format.

However, Petropoulos does teach preview information is displayed in preview window 55. The user may control functional attributes of the preview window including hyperlinks in which a mouse-over or click on a link within the previewed page results in a call to the referenced page ([0042], see also Fig. 1, "53", "63/64", "55", "57", "59"). In addition, Petropoulos teaches advanced preview icon implementation including separating regions in the preview icon which allows the user to dynamically and automatically determine what to preview via a variety of menu buttons ([0060-61], see also Fig. 5, "552", "Home Page").

Furthermore, Petropoulos teaches a mouse-over technology in which the user may simply move the pointer away from the preview and

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the window will close and return to the original display ([0054]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Petropoulos to include a home menu option to return to the original display. The rationale for this inclusion is a home option allows a user to easily return to the original content display to avoid the hassle of the typical backward-forward movement in a browser setting. The Examiner notes that although Petropoulos teaches various menu options, but does not explicitly teach a home option specifically in the preview window (i.e. expanded display), the taught menu options (i.e. functional attribute hyperlinks [0042]) could easily include a home menu option. Furthermore, there are a limited number of predictable ways to transition back to the original format. For example, one could either close the preview window (i.e. expanded display) by clicking a typical close "x" button, select a coded "home" button as disclosed in the instant application, or "deselect" (i.e. move away the cursor) the window as is taught by Petropoulos. As such, it would be obvious for Petropoulos to include a home menu option as opposed to its current teachings because the mouse-over technology yields the same functionality of returning to the original display format that the home menu option provides. The Examiner notes this

rationale has been based on the interpretation resulting from the 112 2nd paragraph rejection detailed above.

41. As per claim 37, Petropoulos discloses the apparatus of claim 35 (as rejected above). Petropoulos further discloses wherein the electronic advertisement comprises a morphing electronic advertisement that includes instructions for interpreting user actions to enable an end user system to display the compact display format and the expanded display format ([0020-26], web page 59 delivered, search result 53, preview icon 63 associated with search result 53, upon action of pointer (i.e. mouse-over) instructions are sent and embedded preview window opened and relevant contextual information inline with user's results rendered, actual content or web page referred by or associated with first result 53 as preview information, see also [0042], preview information displayed in preview window 55, functional attributes of preview window include enabling hyperlinks so that a mouse-over or click on a link within previewed page is active and result in a call to the referenced page, see also Fig. 1, "53", "63/64", "55", "57", "59").

42. As per claim 38, Petropoulos discloses the apparatus of claim 35 (as rejected above). Petropoulos further discloses wherein

the first and second electronic document comprise web pages ([0010], preview information is a "preview window" containing relevant preview information of actual page or document associated with item in results list, see also [0020-25], search results web page 59, preview information displays actual content or the web page referred by or associated with the first result, see also Fig. 1, "59").

43. As per claim 39, Petropoulos discloses the apparatus of claim 35 (as rejected above). Petropoulos further discloses wherein the network locations specified in reference to the one or more menu options comprise network locations provided by or affiliated with a host entity that delivered the first electronic document and the electronic advertisement ([0025-26], preview information displays actual content or the web page referred by or associated with the first result, see also [0029], contextual information regards URL pertaining to web page, see also [0042], enabling active hyperlinks in preview windows so that a mouse-over or click result in a call to the referenced page as well as enabling further mouse-over, which allows the user to use mouse-over in the preview pane).

44. As per claim 40, Petropoulos discloses the apparatus of claim 35 (as rejected above). Petropoulos further discloses further comprising:

wherein the electronic advertisement comprises a target reference to an advertiser network location ([0025], preview information displays actual content or the web page referred by or associated with the first result, see also [0042], enabling active hyperlinks in preview windows so that a mouse-over or click result in a call to the referenced page).

Petropoulos does not explicitly disclose

a database system for storing a price parameter value in association with the electronic advertisement.

However, Petropoulos does teach various constraints are used to sort the pages returned as preview information ([0027-28]). In addition, Petropoulos teaches a user's use of preview information is monitored while the user reviews the results page. More specifically, it monitors which result is being previewed by order or rank, the length of each preview, whether there is a click-through, etc. The attributes of user behavior are forwarded across the network and later used to improve relevancy ([0072-79]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Petropoulos to include storing a price parameter associated with the electronic advertisement. The Examiner notes that in an electronic advertising environment, it is common for there to be a direct correlation between price and performance parameters. As such, the act of monitoring performance (i.e. user interaction) in an online environment provides a way to measure the effectiveness of the content issued to the user, whether it be search results, banner advertisements, etc. Therefore, although Petropoulos does not explicitly teach storing a price value, it would be obvious for a price value to be present as a result of the monitoring and tracking of user performance recited in the teachings of Petropoulos.

45. As per claim 41, Petropoulos discloses the apparatus of claim 35 (as rejected above). Petropoulos further discloses wherein the selection receiving module receives a third user selection of the target reference wherein performance is determined to have occurred upon receipt of the selection of the target reference ([0042], functional attributes of preview window include hyperlinks that a user can mouse over or click on which would result in a call to the referenced page, see also [0073-75], a user's use of preview information is monitored while the user

reviews the results page, it monitors which result is being previewed by order or rank, the length of each preview, whether there is a click-through, etc., attributes of user behavior are forwarded across the network and later used to improve relevancy).

46. As per claim 42, Petropoulos discloses the apparatus of claim 35 (as rejected above). Petropoulos further discloses wherein the selection receiving module receives an indication of user activity associated with the expanded display format, wherein performance is determined to have occurred upon receipt of the indication of the user activity ([0042], functional attributes of preview window include the use of a scroll bar, hyperlinks that a user can mouse over or click on which would result in a call to the referenced page, etc., see also [0073], attributes of user behavior tracked and monitored).

47. As per claim 43, Petropoulos discloses the apparatus of claim 42 (as rejected above). Petropoulos further discloses wherein the user activity comprises a predetermined period of time viewing the expanded display format ([0042], user can dynamically control the duration of the preview window visibility, see also [0073-75], user's use of preview information monitored including

the length of each preview, a long duration indicates high relevancy to a particular result).

48. As per claim 44, Petropoulos discloses the apparatus of claim 42 (as rejected above). Petropoulos further discloses wherein the user activity comprises the user request to view the expanded display format ([0010], displaying preview information associated with each result item, see also [0025], preview information shown when there is a mouse-over a defined area, see also [0073], user's use of preview information monitored including which result is being previewed).

49. As per claim 45, Petropoulos discloses the apparatus of claim 42 (as rejected above). Petropoulos further discloses wherein the user activity comprises a predetermined number of user selections of the one or more menu options available in the expanded display format ([0026], preview information include URLs, with respect to URLs used as preview information these URLs will function as links, see also [0042], enabling active hyperlinks in preview windows so that a mouse-over or click result in a call to the referenced page as well as enabling further mouse-over, which allows the user to use mouse-over in the preview pane, see also [0073-75], a user's use of preview information is monitored while the user reviews the results page,

it monitors which result is being previewed by order or rank, the length of each preview, whether there is a click-through, etc., attributes of user behavior are forwarded across the network and later used to improve relevancy).

50. As per claim 46, Petropoulos discloses the apparatus of claim 35 (as rejected above). Petropoulos further discloses further comprising

a storage system that stores a reference to the electronic advertisement for use by the user in retrieving the electronic advertisement ([0025], preview information displays actual content or the web page referred by or associated with the first result, see also [0029], contextual information regards URL pertaining to web page, see also [0032], preview information includes tags defining the information to be previewed).

51. As per claim 48, Petropoulos discloses the apparatus of claim 35 (as rejected above). Petropoulos further discloses wherein

the second electronic document comprises a document provided by the advertiser ([0025], preview information displays actual content or the web page referred by or associated with the first result, see also [0042], enabling active hyperlinks in preview windows so that a mouse-over or click result in a call to the referenced page) (The Examiner understands the actual content or

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web page that is displayed as preview information to be the second instance, or expanded display format of the instant invention. Furthermore, the Examiner understands if this is indeed the preview information, by this preview information containing hyperlinks (i.e. menu options) which in turn calls upon activation to its respective referenced page, the returned content referenced by the hyperlinks would be the actual content or web page delivered as a web page (i.e. second electronic document). Based on the provided disclosures, this returned content would include both the referenced content and the expanded display format content, as the actual content or web page disclosed represents both of these elements.).

52. As per claim 49, Petropoulos discloses the apparatus of claim 47 (as rejected above). Petropoulos further discloses wherein the document provided by the advertiser comprises a web page from the advertiser's web site ([0025], preview information displays actual content or the web page referred by or associated with the first result, see also [0042], enabling active hyperlinks in preview windows so that a mouse-over or click result in a call to the referenced page) (The Examiner understands the actual content or web page that is displayed as preview information to be the second instance, or expanded display format of the instant invention. Furthermore, the

Examiner understands if this is indeed the preview information, by this preview information containing hyperlinks (i.e. menu options) which in turn calls upon activation to its respective referenced page, the returned content referenced by the hyperlinks would be the actual content or web page delivered as a web page (i.e. second electronic document). Based on the provided disclosures, this returned content would include both the referenced content and the expanded display format content, as the actual content or web page disclosed represents both of these elements.).

53. As per claim 52, Petropoulos discloses a method, comprising:

delivering a first electronic document including content and a first instance of an electronic advertisement, the first instance of the electronic advertisement including an associated expansion icon and being delivered in a compact display format ([0020-26], web page 59 delivered, search result 53, preview icon 63 associated with search result 53, see also Fig. 1, "53", "63/64");

receiving a first user selection for the expansion icon associated with first instance of the electronic advertisement ([0020-26], web page 59 delivered, search result 53, preview icon 63 associated with search result 53, upon action of pointer (i.e. mouse-over) embedded preview window opened and relevant

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contextual information inline with user's results rendered, actual content or web page referred by or associated with first result 53 as preview information, see also [0042], preview information displayed in preview window 55, see also Fig. 1, "53", "63/64", "55", "57", "59");

delivering a second electronic document replacing the first electronic document, the second electronic document including the content and a second instance of the electronic advertisement in an expanded display format, the expanded display format comprising one or more menu options and a reference to a network location for retrieving specified content associated with each menu option ([0020-26], web page 59 delivered, search result 53, preview icon 63 associated with search result 53, upon action of pointer (i.e. mouse-over) embedded preview window opened and relevant contextual information inline with user's results rendered, actual content or web page referred by or associated with first result 53 as preview information, see also [0042], preview information displayed in preview window 55, functional attributes of preview window include enabling hyperlinks so that a mouse-over or click on a link within previewed page is active and result in a call to the referenced page, see also Fig. 1, "53", "63/64", "55", "57", "59") (The Examiner understands the first electronic document (i.e. search results web page 59) containing the search result 53 and preview icon 63 associated

with search result 53 has been replaced by a second electronic document now containing the search result 53, preview icon 63 and preview information within preview window 55. As such, the limitations as currently written have been satisfied.);

receiving a second user selection of one of the one or more menu options ([0042], preview information displayed in preview window 55, functional attributes of preview window include enabling hyperlinks so that a mouse-over or click on a link within previewed page is active and result in a call to the referenced page).

Petropoulos does not explicitly disclose

delivering a third electronic document replacing the second electronic document, the third electronic document including content from the referenced network location associated with the menu option selected and including the second instance of the electronic advertisement in the expanded display format.

However, Petropoulos does teach that actual content or the web page referred by or associated with first result 53 is displayed as preview information ([0020-24]). This preview information is displayed in preview window 55. The user may control functional attributes of the preview window including hyperlinks in which a mouse-over or click on a link within the previewed page results

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in a call to the referenced page ([0042], see also Fig. 1, "53", "63/64", "55", "57", "59").

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Petropoulos to include delivering a second document including the referenced content and the electronic advertisement initially displayed in the expanded format. The rationale for this inclusion is that this would enable Petropoulos to deliver the content while maintaining the advertising content in direct view of the user. Common sense dictates that the longer a user is subjected to particular content, the more impact and effect the content will have on the user. The Examiner notes that although the particular language of the instant invention is not explicitly disclosed in Petropoulos, based on the broadest reasonable interpretation, the Examiner understands the actual content or web page that is displayed as preview information to be the second instance, or expanded display format of the instant invention. Furthermore, the Examiner understands if this is indeed the preview information, by this preview information containing hyperlinks (i.e. menu options) which in turn calls upon activation to its respective referenced page, the returned content referenced by the hyperlinks would be the actual content or web page delivered as a web page (i.e. second electronic document). Based on the provided

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disclosures, this returned content would include both the referenced content and the expanded display format content, as the actual content or web page disclosed represents both of these elements. As such, the Examiner contends the limitations as currently written have been satisfied by the provided recitations.

54. **Claims 13, 16, 30, 33, 47 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Petropoulos et al. (US 2003/0146939 A1) (hereinafter Petropoulos) in view of Ogura et al. (US 2002/0165767 A1) (hereinafter Ogura).**

55. As per claim 13, Petropoulos discloses the computer-implemented method of claim 12 (as rejected above).

Petropoulos does not explicitly disclose

wherein the user may bookmark the electronic advertisement using the reference.

However, Ogura teaches a bookmark button that when pressed allows a user to easily link with the advertisement and store the bookmark in an advertisement log (bookmark) table ([0092], see also [0118-122]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Petropoulos to include the capability to bookmark an electronic advertisement. The rationale for combining in this manner is that both Petropoulos and Ogura are directed to advertising via an online environment.

Furthermore, this inclusion would enable Petropoulos to provide a user that ability to save desired content and easily access it again at a later time, thus increasing the likelihood of a user making a purchase or some other typical online conversion.

56. As per claim 16, Petropoulos discloses the computer-implemented method of claim 1 (as rejected above).

Petropoulos does not explicitly disclose

wherein the second electronic document comprises an electronic document that includes functionality to permit the user to purchase one or more items.

However, Ogura teaches an online shopping environment allowing a user to purchase a piece of merchandising from a browsing site ([0158]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Petropoulos to include online

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shopping functionality. The rationale for combining in this manner is that both Petropoulos and Ogura are directed to advertising via an online environment. Furthermore, this inclusion would enable Petropoulos to provide a user the ability to purchase desired merchandise, thus increasing revenue for the online system and further increasing campaign success for both the direct online system as well as any third-party merchants connected with the online environment.

57. As per claim 30, Petropoulos discloses the apparatus of claim 29 (as rejected above).

Petropoulos does not explicitly disclose

wherein the user may bookmark the electronic advertisement using the reference.

However, Ogura teaches a bookmark button that when pressed allows a user to easily link with the advertisement and store the bookmark in an advertisement log (bookmark) table ([0092], see also [0118-122]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Petropoulos to include the capability to bookmark an electronic advertisement. The rationale

for combining in this manner is that both Petropoulos and Ogura are directed to advertising via an online environment.

Furthermore, this inclusion would enable Petropoulos to provide a user that ability to save desired content and easily access it again at a later time, thus increasing the likelihood of a user making a purchase or some other typical online conversion.

58. As per claim 33, Petropoulos discloses the apparatus of claim 18 (as rejected above).

Petropoulos does not explicitly disclose

wherein the second electronic document comprises an electronic document that includes functionality to permit the user to purchase one or more items.

However, Ogura teaches an online shopping environment allowing a user to purchase a piece of merchandising from a browsing site ([0158]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Petropoulos to include online shopping functionality. The rationale for combining in this manner is that both Petropoulos and Ogura are directed to advertising via an online environment. Furthermore, this

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inclusion would enable Petropoulos to provide a user the ability to purchase desired merchandise, thus increasing revenue for the online system and further increasing campaign success for both the direct online system as well as any third-party merchants connected with the online environment.

59. As per claim 47, Petropoulos discloses the apparatus of claim 45 (as rejected above).

Petropoulos does not explicitly disclose

wherein the user may bookmark the electronic advertisement using the reference.

However, Ogura teaches a bookmark button that when pressed allows a user to easily link with the advertisement and store the bookmark in an advertisement log (bookmark) table ([0092], see also [0118-122]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Petropoulos to include the capability to bookmark an electronic advertisement. The rationale for combining in this manner is that both Petropoulos and Ogura are directed to advertising via an online environment.

Furthermore, this inclusion would enable Petropoulos to provide a

user that ability to save desired content and easily access it again at a later time, thus increasing the likelihood of a user making a purchase or some other typical online conversion.

60. As per claim 50, Petropoulos discloses the apparatus of claim 35 (as rejected above).

Petropoulos does not explicitly disclose

wherein the second electronic document comprises an electronic document that includes functionality to permit the user to purchase one or more items.

However, Ogura teaches an online shopping environment allowing a user to purchase a piece of merchandising from a browsing site ([0158]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Petropoulos to include online shopping functionality. The rationale for combining in this manner is that both Petropoulos and Ogura are directed to advertising via an online environment. Furthermore, this inclusion would enable Petropoulos to provide a user the ability to purchase desired merchandise, thus increasing revenue for the online system and further increasing campaign success for both

the direct online system as well as any third-party merchants connected with the online environment.

61. **Claims 17 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Petropoulos et al. (US 2003/0146939 A1) (hereinafter Petropoulos) in view of Ogura et al. (US 2002/0165767 A1) (hereinafter Ogura) as applied to claims 13, 16, 30, 33, 47 and 50 above, and further in view of Morgenthaler et al. (U.S. 2002/0032677) (hereinafter Morgenthaler).**

62. As per claim 17, Petropoulos in view of Ogura discloses the computer-implemented method of claim 16 (as rejected above).

Petropoulos does not explicitly disclose further comprising:

receiving feedback information related to a user's purchase of one or more items.

However, Morgenthaler teaches monitoring a user's Internet use habits and items purchased on the Internet via a cookie ([0055]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Petropoulos and Ogura to include tracking user purchases. The rationale for combining in this manner is that Petropoulos, Ogura and Morgenthaler are all

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directed to advertising via an online environment. Furthermore, tracking user purchases would enable Petropoulos and Ogura to determine the effectiveness of an advertisement and adjust the campaign accordingly to achieve and maintain successful results.

63. As per claim 34, Petropoulos in view of Ogura discloses the apparatus of claim 33 (as rejected above).

Petropoulos does not explicitly disclose further comprising feedback means for receiving feedback information related to a user's purchase of one or more items.

However, Morgenthaler teaches monitoring a user's Internet use habits and items purchased on the Internet via a cookie ([0055]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Petropoulos and Ogura to include tracking user purchases. The rationale for combining in this manner is that Petropoulos, Ogura and Morgenthaler are all directed to advertising via an online environment. Furthermore, tracking user purchases would enable Petropoulos and Ogura to determine the effectiveness of an advertisement and adjust the campaign accordingly to achieve and maintain successful results.

64. **Claim 51 is rejected under 35 U.S.C. 103(a) as being unpatentable over Petropoulos et al. (US 2003/0146939 A1) (hereinafter Petropoulos) in view of Morgenthaler et al. (U.S. 2002/0032677) (hereinafter Morgenthaler).**
65. As per claim 51, Petropoulos discloses the apparatus of claim 49 (as rejected above).
- Petropoulos does not explicitly disclose further comprising a feedback module that receives feedback information related to a user's purchase of one or more items.
- However, Petropoulos does teach a user's use of preview information is monitored while the user reviews the results page. More specifically, it monitors which result is being previewed by order or rank, the length of each preview, whether there is a click-through, etc. The attributes of user behavior are forwarded across the network and later used to improve relevancy ([0072-79])
- In addition, Morgenthaler teaches monitoring a user's Internet use habits and items purchased on the Internet via a cookie ([0055]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Petropoulos to include tracking user purchases. The rationale for combining in this manner is that Petropoulos and Morgenthaler are directed to advertising via an online environment. Furthermore, tracking user purchases would enable Petropoulos to determine the effectiveness of an advertisement and adjust the campaign accordingly to achieve and maintain successful results.

Response to Arguments

66. Applicant's arguments with respect to claims 1, 18 and 35, **as amended**, and arguments with respect to newly added claim 52 have been considered but are moot in view of the new ground(s) of rejection. The Examiner contends the newly amended and added limitations have been fully addressed in the rejection above. However, the Examiner will provide further detail below to provide Applicant with the Examiner's understanding of the applied references and the claimed limitation equivalencies.

67. In the remarks, the Applicant argues with respect to claim 1, **as amended**, the following:

68. Argument 1: "the search result page (nor any individual search result entry) displayed in the Petropoulos system is not 'a first

and second instance of an electronic advertisement', as recited in claim 1."

Argument 2: "the relied upon portion of Petropoulos related to a search result and associated preview web page is not the same as Applicant's claims first and second instance of an advertisement nor transitioning from a compact display format into an expanded display format...there is not teaching or suggestion in the relied upon portions that two instances of an advertisement are delivered at a same time. Rather...the two different elements are delivered sequentially at two different times."

Argument 3: "Petropoulos does not teach or suggest 'delivering, from the server, a second electronic document including content from the referenced network location associated with the menu option selected and including the second electronic advertisement". The Applicant has argued the Examiner has taken official notice with regards to this feature.

In response to these arguments, the Examiner respectfully disagrees.

69. The Examiner would direct the Applicant to Figure 1 to follow the Examiner's reasoning. As per the rejection above, Petropoulos discloses a search results web page 59 delivered to the user. Specifically, search result 53, preview icon 63/64 and preview window are all displayed as part of search results web page 59. As such, the Examiner understands the claimed limitations to have the following equivalencies:

- compact format: search result, Fig. 1, "53"
- expansion icon: preview icon, Fig. 1, "63/64"
- expanded format: preview window, Fig. 1, "55"
- first electronic document: web page, Fig. 1, "59"
- first instance: search result, Fig. 1, "53"
- second instance: preview window, Fig. 1, "55"

Therefore, as per Argument 1, the Examiner contends the disclosure of these said equivalencies indeed satisfies the claimed limitation of delivering a first and second instance of an electronic advertisement.

Furthermore, as per Argument 2, it appears the Applicant is reading limitations into the claim. Although the Applicant may intend from the claim language that the two instances are delivered at the same time, the Examiner does not see this intent required by the current claim language. Moreover, the Examiner can find no support in the Applicant's specification in which the instant invention actually delivers both instances at the same

time. Therefore, the Examiner is not persuaded by this particular argument and as such, the Examiner contends the relied upon portions of Petropoulos satisfies the claimed limitations as currently written.

As per Argument, the Examiner has appropriately addressed this limitation in the rejection above. As this limitation has been amended, the Examiner has provided further clarification and detail to address the amended limitation and has in no way relied on Official Notice for rationale.

Therefore, the Examiner hereby maintains the rejection of amended claim 1. The Examiner also maintains the rejection of amended claims 18 and 35 for similar reasons. The Examiner maintains the rejection of dependent claims 2-17, 19-34 and 36-51. Moreover, the newly added claim 52 has been fully addressed in the rejection above.

Conclusion

70. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

71. Any inquiry concerning this communication or earlier communications from the examiner should be directed to WILLIAM A. BRANDENBURG whose telephone number is (571)270-5488. The examiner can normally be reached on Monday-Thursday 6:30 am - 5:00 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/W. A. B./
Examiner, Art Unit 3622

/J. V./
Examiner, Art Unit 3622

/Eric W. Stamber/
Supervisory Patent Examiner, Art Unit 3622